APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,172	01/14/2004	Nizar Allibhoy	PU050093	4824

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EXAMINER
ONYEZIA, CHUKS N

ART UNIT	PAPER NUMBER
3691	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/758,172	ALLIBHOY ET AL.
	Examiner	Art Unit	
	CHUKS ONYEZIA	3691	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04/18/2008</u>.

2a) ☒ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-28</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>25 July 2007</u> is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114,
including the fee set forth in 37 CFR 1.17(e), was filed in this
application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the
fee set forth in 37 CFR 1.17(e) has been timely paid, the
finality of the previous Office action has been withdrawn
pursuant to 37 CFR 1.114. Applicant's submission filed on
04/18/2008 has been entered.

Response to Amendment

1.   In the amendment filed 05/17/2010, the following has
occurred: claims 1, and 16 have been amended, claims 20-28 are
canceled. Claims 1-19 are currently presented and have been
considered for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claims 1-19 are rejected under 35 U.S.C. 101 because the
claimed invention is directed to non-statutory subject matter.
Based on Supreme Court precedent, a method/process claim must

(1) be tied to machine (such as a particular apparatus) (see at

least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409

U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88

(1876)) or (2) transform underlying subject matter (such as an

article or materials) to a different state or thing (see at

least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A

method/process claim that fails to meet one of the above

requirements is not in compliance with the statutory

requirements of 35 U.S.C. 101 for patent eligible subject

matter. . Here the claims fails to meet the above requirements

because the steps are neither tied to machine (such as a

particular apparatus) nor physically transform underlying

subject matter (such as an article or materials) to a different

state or thing. Examiner finds that the recitation of "Database"

can reasonably be interpreted as software, merely using paper

and pen, or the human mind.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35

U.S.C. 112:

> The specification shall conclude with one or more claims particularly
> pointing out and distinctly claiming the subject matter which the applicant
> regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as

the invention. examiner notes that the recitation of "Network

operator" as claimed is reasonable interpreted as a limitation

that is directed to a human. in the amended preamble of claim 1

applicant attempts to define network operator as a third party

separate from user receiver and content provider. for this

reason examiner has not given the limitation of network operator

patentable weight

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

6.   Claims 1-5, 7-9, and 12-19 are rejected under 35 U.S.C.

103(a) as being unpatentable over Dejaeger, U.S. Patent No.

6,296,185 B1 (PTO-892 Reference A) in view of Payton U.S. Patent

No. 5,790,935 (PTO-892 Reference C).

7.   As per claim 1, Dejaeger teaches a method of tracking at
least one financial transaction between a user receiver and at
least one content provider which transmits on-demand content to
the user receiver by a network, wherein the tracking method is
performed by a third party separate from the user receiver and
separate from the at least one content provider, the method
comprising the steps of:

   a.   storing preliminary information said at least one
   financial transactions in a third party controlled data
   base (see column 34 lines 44-58);

   b.   obtaining supplemental information for said at least
   one financial transactions in said third party controlled
   data base, wherein said obtaining step is performed by the
   third party (column 34 lines 44-58);

   c.   storing said supplemental information for said at
   least one financial transactions in said third party
   controlled data base (column 34 lines 44-58);

   d.   displaying summary information for each of the
   plurality of financial transactions upon receipt of a
   display request from the user receiver, wherein said
   summary information is comprised of at least a portion of
   said stored preliminary information (column 16 lines 48-56)

examiner interprets the users operation of the checkout
system as a request;

e.   permitting selection of one or more of the financial
transactions from said at least one financial transaction
by the user receiver for finalization (column 10 lines 62-
67);

f.   finalizing said selected one or more financial
transactions (column 11 lines 14-25); and

g.   providing transaction finalization information to each
of the at least one content providers affected by said
selected one or more financial transactions wherein content
corresponding to each of said selected one or more
financial transactions is authorized to be transmitted to
said user receiver by said at least content providers
affected by said selected one or more financial
transactions.(column 27 lines 25-32).

However, Dejaeger does not explicitly disclose the
request being for "on-demand content". Payton discloses a
system that receives a subscribers request for on-demand
content (see Payton Fig 3b). It would have been obvious to
combine the teachings of Dejaeger with those of Payton for
the purpose of broadening the types of goods and services
that are allowed to be purchased.

8.   As per claim 2, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the step of displaying at
least one advertisement simultaneously with said summary
information (column 59 lines 47-65).

9.   As per claim 3, Dejaeger teaches the above limitations of
claim 2. Dejaeger further teaches said at least one
advertisement includes linking information to a specific content
provider (column 59 lines 47-65).

10. As per claim 4, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches said summary information is
comprised of purchase tracking information (column 16 lines 48-
56).

11. As per claim 5, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches said summary information is
comprised of purchase status information (column 16 lines 48-
56).

12. As per claim 7, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches said finalizing step is
further comprised of the step of displaying at least one
checkout display screen (column 16 lines 48-56).

13. As per claim 8, Dejaeger teaches the above limitations of
claim 7. Dejaeger further teaches the step of displaying at

least one advertisement simultaneously with said at least one
checkout display screen (column 59 lines 47-65).

14. As per claim 9, Dejaeger teaches the above limitations of
claim 8. Dejaeger further teaches said at least one
advertisement includes linking information when selected by a
user allows said user to access a specific content provider
(column 59 lines 47-65).

15. As per claim 12, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the steps of: permitting
selection of one or more of the financial transactions by the
user receiver for additional information inquiry; obtaining said
additional information for said selected financial transactions
from said third party controlled data base; and displaying said
additional information for said selected financial transactions
(column 34 lines 44-58).

16. As per claim 13, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the steps of: permitting
selection of one or more of the financial transactions by the
user receiver for additional information inquiry; obtaining said
additional information for said selected financial transactions
from the at least one content provider affected by said selected
one or more financial transactions; and displaying said

additional information for said selected financial transactions
(column 34 lines 44-58).

17. As per claim 14, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the step of finalizing said
selected one or more financial transactions is performed by a
network operator (column 34 lines 40-54).

18. As per claim 15, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the step of charging each of
the at least one content providers affected by said selected one
or more financial transactions (column 26 lines 47-66).

19. As per claim 16, Dejaeger teaches the above limitations of
claim 15. Dejaeger further teaches said charging step is
performed by said network operator of said network (column 26
lines 47-66).

20. As per claim 17, Dejaeger teaches the above limitations of
claim 15. Dejaeger further teaches said fee is based on a total
number of finalized financial transactions (column 26 lines 47-
66).

21. As per claim 18, Dejaeger teaches the above limitations of
claim 15. Dejaeger further teaches said fee to a specific
content provider of said at least one content providers is based
on a total number of finalized financial transactions occurring

between said user receiver and said specific content provider
(column 26 lines 47-66).

22. As per claim 19, Dejaeger teaches the above limitations of
claim 15. Dejaeger further teaches said fee is based on a cost
associated with said finalized financial transactions (column 26
lines 47-66).

23. As per claim 6, Dejaeger teaches the above limitations of
claim 1. Dejaeger further teaches the steps of: determining
display capabilities for the user receiver; and matching a
format, from a Plurality of formats, corresponding to said
displayed summary information to said determined display
capabilities (column 16 lines 48-56; the interactive customer
interface terminal includes a display monitor which is provided
to display retail information to the customer during operation
of the checkout system. For example, transaction information
such as item price, item description, total amount of the
transaction, instructions, etcetera is displayed to the customer
via the display monitor during operation of the checkout system
in either its assisted mode of operation or its self-service
mode of operation) examiner notes that a determination of
display capabilities and matching format compatibilities is
necessary in order to display such information.

    while Dejaeger does not explicitly disclose the use of a

Set top box as the user's receiver, Dejaeger discloses the use
of a display monitor as the customer interface (column 16 lines
48-56; the interactive customer interface terminal includes a
display monitor which is provided to display retail information
to the customer during operation of the checkout system). Payton
discloses the use of a subscriber's playback device being a
television, audio system, or computer (See Payton Col 4 Lns 50-
54). It would have been obvious to exchange the checkout
terminal of Dejaeger with the at home user POS display of Payton
for the purpose of allowing flexibility of purchase locations.

24. As per claim 11, Dejaeger teaches the above limitations of
claim 6. Dejaeger further teaches said displayed summary
information utilizes only a portion of said determined display
capabilities of the user receiver (See Figure 21).

**25. Claim 10 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Dejaeger, U.S. Patent No. 6,296,185 B1 (PTO-
892 Reference A) in view of Fields, U.S. Patent No. 4,400,724
(PTO-892 Reference B).**

26. As per claim 10, Dejaeger teaches the above limitations of
claim 1. However Dejaeger does not teach said displayed summary
information is displayed as a semi-transparent screen overlay.
The Examiner notes, displaying information in this fashion does
not modify the operation of Dejaeger's invention. To modify

Dejaeger's display to include a semi-transparent screen overlay
would have been obvious to the skilled artisan because the
inclusion of such view would have been an obvious matter of
design choice in light of the method already discloses by
Dejaeger (see Fields, column 11 lines 2-7). Such a modification
would not have otherwise affected Dejaeger and would have merely
represented one of numerous views that the skilled artisan would
have found obvious for the purposes of displaying multiple
messages, already disclosed by Dejaeger. Additionally,
applicant has not persuasively demonstrated the criticality of
providing this arrangement versus the arrangement discloses in
Dejaeger. See In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA
1950).

Response to Arguments

27. Applicant's arguments filed 01/25/2009 have been considered
but are moot in view of the new ground(s) of rejection.

28. <u>Applicant argues that:</u>

Dejaeger does not disclose "Network operator".

>   <u>Examiner responds that:</u>

Applicant's argument has been considered but examiner notes that
the recitation of "Network operator" as claimed is reasonable
interpreted as a limitation that is directed to a human. in the

amended preamble of claim 1 applicant attempts to define network

operator as a third party separate from user receiver and

content provider. for this reason examiner has not given the

limitation of network operator patentable weight

29. Applicant argues that:

Dejaeger does not disclose "the delivery of on-demand

programming".

        Examiner responds that:

Applicant is correct. Dejaeger directly teaches a method of

tracking financial transactions between user and merchant (see

Dejaeger Col. 3 Lns. 19-32). Dejaeger does not explicitly

disclose the request being for "on-demand content". Payton

discloses a system that receives a subscribers request for on-

demand content (see Payton Fig 3b). It would have been obvious

to combine the teachings of Dejaeger with those of Payton for

the purpose of broadening the types of goods and services that

are allowed to be purchased. All that is being done is applying

the system of Dejaeger, and allowing for the purchase of 'on

demand content' to be one of the underlying transactions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUKS ONYEZIA whose telephone number is (571)270-1372. The examiner can normally be reached on Monday - Thursday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. O./   /Alexander Kalinowski/
Examiner, Art Unit 3691   Supervisory Patent
                                     Examiner, Art Unit 3691

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